

## **REMARKS**

### **Interview Summary**

Applicant's counsel greatly appreciates the courtesy extended by Examiner Fubara in granting an interview.

A brief telephone interview was held on March 11, 2008. In the interview, applicant's representative, Dr. Gloria Gusler, asked Examiner Fubara about the Information Disclosure Statement filed on May 16, 2003. Applicants would like to thank the Examiner for clarifying that the references on the Information Disclosure Statement of May 16, 2003 were considered.

### **Status of Claims**

Claim 4 is pending. Claim 4 is amended. Claims 2, 7, 10, 14, 15, 17, 19, 21, 23, 27, 28, 34, 39 - 46, 50, and 52 are canceled. These claims are canceled without prejudice to reclaiming the subject matter therein in a subsequent application.

Amendment to claim 4 is supported in the originally filed specification. The claim has been amended to reflect the language of claim 4 prior to the amendment made in the October 18, 2007 response to the June 18, 2007 Office Action with the exception that "medical device" has been replaced by "stent."

Reconsideration and reexamination are respectfully requested in view of the foregoing claim amendments and the remarks presented below.

### **Claim Rejections under 35 U.S.C. § 112, first and second paragraphs**

The Examiner rejected claims 2, 4, 7, 10, 14, 15, 17, 19, 21, 23, 27, 28, 34, 39 - 46, 50, and 52 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description

requirement. Specifically, the Examiner states that "the specification as filed does not envision a layer comprising drug and polymer that is supported by the surface of the stent," and that therefore, the phrase "a drug and polymer supported by a surface of the stent" is new matter.

The Examiner rejected claims 2, 4, 7, 10, 14, 15, 17, 19, 21, 23, 27, 28, 34, 39 - 46, 50, and 52 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that the phrase "a drug and polymer supported by a surface of the stent" is unclear.

Without concurring with the Examiner's assertions, applicant has amended claim 4 to remove the phrase "supported by a surface of the stent." Applicant believes that this amendment addresses the concerns of the Examiner. Applicant respectfully requests the removal of the 35 U.S.C. § 112, first and second paragraph rejections with respect to claim 4, and allowance of claim 4.

Rejections of claims 2, 7, 10, 14, 15, 17, 19, 21, 23, 27, 28, 34, 39 - 46, 50, and 52 are moot in light of their cancellation.

#### Claim Rejections under 35 U.S.C. § 103

The Examiner rejected claims 2, 4, 7, 10, 14, 15, 17, 21, 23, 27, 28, 34, 39 - 46, 50 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Pacetti et al., United States Patent No. 6,663,662.

Applicant respectfully traverses the rejection for at least the following reason.

The present application, application 09/966,036 was filed on September 28, 2001. Pacetti et al. was filed on December 28, 2000 and was published on September 5, 2002. Therefore Pacetti is a reference under 35 U.S.C. § 103(a) via 35 U.S.C. § 102(c).

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. §103 via 35 U.S.C. §102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention, "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person" (see MPEP Section 706.02(I)(1)(I)). A statement of an attorney of record can be sufficient evidence to establish common ownership (see MPEP Section 706.02(I)(2)(II)). As established by the enclosed Statement of Common Ownership (Exhibit A), at the time the inventions of the current application were made, the inventions of the current application and Pacetti et al., were owned by, or subject to an obligation of assignment to, Advanced Cardiovascular Systems, Inc., a California corporation. Since the Applicant has established common ownership, Pacetti et al. is disqualified as prior art and should be removed as a reference. Accordingly, claims 2, 4, 7, 10, 14, 15, 17, 21, 23, 27, 28, 34, 39 - 46, 50 and 52 are patentably allowable over Pacetti et al. under 35 U.S.C. § 103(a). Applicant respectfully requests the removal of the 35 U.S.C. § 103(a) rejection in view of Pacetti, and allowance of claim 4.

Rejections of claims 2, 7, 10, 14, 15, 17, 19, 21, 23, 27, 28, 34, 39 - 46, 50, and 52 are moot in light of their cancellation.

The Examiner has rejected claims 2, 7, 10, 14, 34, 39 - 41, 44, 50 and 52 under 35 U.S.C. § 103(a) as being unpatentable over Kanikanti et al., United States Patent No. 5,900,425, in view of Sinclair et al., United States Patent No. 5,760,118, and further in view of Yan, United States Patent No. 6,240,616.

The rejection of claims 2, 7, 10, 14, 34, 39 - 41, 44, 50 and 52 is moot in light of their cancellation.

The Examiner has rejected claims 15, 17, 19, 21, 23, 27, 28, 42, 43, 45, and 46 under 35 U.S.C. § 103(a) as being unpatentable over Kanikanti et al. in view of Sinclair et al. and further in view of Yan.

The rejection of claims 15, 17, 19, 21, 23, 27, 28, 42, 43, 45, and 46 is moot in light of their cancellation.

**CONCLUSION**

In light of the foregoing claim amendments and remarks, this application is considered to be in condition for allowance. Applicant respectfully requests the allowance of pending claim 4. No new matter has been added, and all cancellations have been made merely to expedite prosecution of the application. Accordingly, applicant reserves the right to continue pursuing previously presented arguments in any divisional, continuation, or continuation-in-part applications.

If necessary to ensure a timely response, this paper should be considered as a petition for an Extension of Time sufficient to provide a timely response. The undersigned authorizes the examiner to charge any fees that may be required, or credit of any overpayment to be made, to **Deposit Account No. 07-1850.**

Should the Examiner have any questions regarding this communication, the Examiner is invited to contact the undersigned at the telephone number shown below.

Date: March 31, 2008

Respectfully submitted,

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Application 09/966,036  
Amendment Dated Monday, March 31, 2008  
Reply to Office Action of January 24, 2008

Attorney Docket: 50623.132

## **APPENDIX**

Application 09/966,036  
Amendment Dated Monday, March 31, 2008  
Reply to Office Action of January 24, 2008

Attorney Docket: 50623.132

## **EXHIBIT A**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Examiner:

Dorrie M. Happ

Blessing M. Fubara

Serial No.: 09/996,036

Art Unit: 1618

Filed: September 28, 2001

Attorney's Docket Number: 50623.132

Customer number: 45159

Confirmation number: 4580

Title: A Medical Device Containing Light-Protected Therapeutic Agent And a  
Method For Fabricating The Same

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT OF COMMON OWNERSHIP**

Dear Examiner Fubara:

At the time the invention of the current application (U.S. Serial Number 09/966,036) was made, the inventions of the current application and Pacetti et al. (U.S. Patent No. 6,663,662) were owned by, or subject to an obligation of assignment to, Advanced Cardiovascular Systems, Inc., a California corporation.

Date:

MA 31 2001

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Respectfully submitted,

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